

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

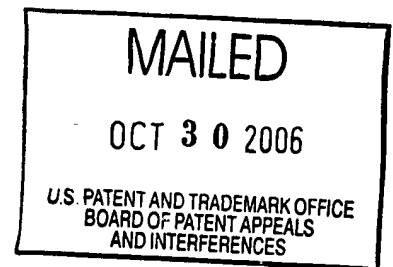
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN PAUL MORGAN

Appeal No. 2006-2446
Application No. 09/933,494

ON BRIEF



Before HAIRSTON, BARRY, and SAADAT, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of pending claims 1 through 3, 5 through 10, 12 through 21 and 23 through 27.

The disclosed invention relates to a method and system for using an adapter in a computer without a local hard drive. The adapter is coupled to the CPU in the computer, and receives local disk I/O requests from the CPU. The adapter translates disk I/O requests into network I/O requests, and at least one network resource in communication with the adapter satisfies the local disk I/O requests.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A system, comprising:

a computer including a central processing unit (CPU)
but not including a local hard disk drive;

an adapter coupled to the CPU for receiving local disk
I/O requests therefrom, the adapter translating disk I/O
requests into network I/O requests; and

at least one network resource communicating with the
adapter for satisfying the local disk I/O requests.

The references relied on by the examiner are as follows:

| | | |
|--------------------------|-----------|-----------------------|
| Kathail et al. (Kathail) | 5,802,365 | Sept. 1, 1998 |
| Kedem et al. (Kedem) | 6,477,624 | Nov. 5, 2002 |
| | | (filed Oct. 16, 2000) |

Claims 1 through 3, 5, 6, 8, 10, 12 through 15, 17, 19
through 21, 23, 24 and 26 stand rejected under 35 U.S.C. § 102(e)
as being anticipated by Kedem.

Claims 9, 18 and 27 stand rejected under 35 U.S.C. § 103(a)
as being unpatentable over Kedem.

Claims 7, 16 and 25 stand rejected under 35 U.S.C. § 103(a)
as being unpatentable over Kedem in view of Kathail.

Reference is made the briefs and the answer for the
respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us,
and we will reverse the anticipation rejection of claims 1
through 3, 5, 6, 8, 10, 12 through 15, 17, 19 through 21, 23, 24
and 26, and reverse the obviousness rejections of claims 7, 9,
16, 18, 25 and 27.

In Kedem (Figure 2), a local data image manager (LDIM) 202 functions to intercept read/write requests, and is programmed to determine whether cached image data at the computer 100 is the most up-to-date version of the same image data stored at a remote site 206 (Abstract; column 4, lines 4 through 9; column 9, lines 9 through 15). If the version of the image data stored at the computer is not the latest version, then the image data is retrieved from the remote site (Abstract; column 4, lines 24 through 37; column 9, lines 28 through 35).

According to the examiner (answer, pages 4 and 5), "[t]he factual evidence that the LDIM card takes local storage requests (disk I/O requests) and forwards them over a network (as network I/O requests) to access remote storage, shows that a 'translation' operation takes place."

Appellant argues throughout the briefs that Kedem does not translate the I/O requests as required by all of the claims on appeal. Appellant also argues (reply brief, pages 1 and 2) that the mere forwarding of the I/O requests in Kedem is not the same as the translating/transforming of the I/O requests as required by the disclosed and claimed invention.

We agree with the appellant's arguments. In Kedem, the image data stored at the local computer and at the remote site are the same data, and the image data are even stored at the same sector address at both sites (column 4, lines 31 through 34; column 5, lines 12 through 17; column 9, lines 20 through 27;

column 12, lines 25 through 36; column 15, line 64 through column 16, line 3). Since the image data is stored at the same sector address at both locations, the I/O requests (addresses) for the image data are the same no matter which site is chosen by the LDIM 202 to furnish the image data. In fact, Kedem specifically states (column 10, lines 17 through 20) that the LDIM 202 "merely forwards" all requests to the remote site.

An inherency teaching must be necessarily present in the structure described in the applied reference. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The examiner must provide extrinsic evidence, rather than an opinion, that makes clear that "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In re Robertson, 169 F.3d 743, 744-45, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Thus, the anticipation rejection of claims 1 through 3, 5, 6, 8, 10, 12 through 15, 17, 19 through 21, 23, 24 and 26 is reversed because it is not necessary for the Kedem system to perform any translating/transforming of the I/O requests.

For all the reasons expressed supra, the obviousness rejection of claims 9, 18 and 27 is reversed.

The obviousness rejection of claims 7, 16 and 25 is reversed because the teachings of Kathail do not cure the noted shortcoming in the teachings of Kedem.

DECISION

The decision of the examiner rejecting claims 1 through 3, 5, 6, 8, 10, 12 through 15, 17, 19 through 21, 23, 24 and 26 under 35 U.S.C. § 102(e) is reversed, and the decision of the examiner rejecting claims 7, 9, 16, 18, 25 and 27 under 35 U.S.C. § 103(a) is reversed.

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